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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,323	08/31/2000	Oscar Lee Avant	08049.0010	3894

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER
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KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/651,323

Applicant(s)

AVANT ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed on December 9, 2003. In the  
5 amendment, claims 1, 17, 18, and 34-36 were amended. Currently, claims 1-36 remain for  
examination.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on  
sale in this country, more than one year prior to the date of application for patent in the United States.

15 3. Claims 1, 7, 10-12, 14, 17, 18, 24, 27-29, 31, and 34-36 are rejected under 35  
U.S.C. 102(b) as being anticipated Borgendale et al. (US 5,734,568, “Borgendale” hereinafter).

Re claims 1, 7, 10, 17, 18, and 34-36, Borgendale teaches a system and the method for  
processing and sorting a plurality of mailpiece comprising following steps: marking an  
individual mailpieces with unique identification marking 24, and creating an identification file  
20 (called electronic folder) corresponding to the identification number (col. 1, lines 20-49). The  
system allows accesses to the identification file from various locations (or nodes) such as  
sending postal location, destination location, and the remote processing system 14 which are  
connected via network (see figure 1, col. 3, lines 38+). Although the marking 24 is printed on  
the front side, as some other references indicate, such identification markings also can be printed

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on the back side of the mail (See US 5,009,321 to Keough, cited by the Applicant). In the Examiner's opinion, printing the indicia on front or back is not patentably distinct.

Re claims 7 and 24, an assigned serial number for each mailpiece can be considered as a mailpiece sequence code.

5 Re claims 10 and 27, as shown in figure 2, the electronic folder contains a serial number 24.

Re claims 11, 14, 28, and 31, the component parts of the electronic folder such as a mail serial no 24, city/state/zip 42, address/street no 422, in broader interpretation, can be considered as a postal code.

10 Re claims 12 and 29, the identification file 16 further contains an address block image 45, OCR programs 52, and operating system 54, and the operating system, although not explicitly suggested, contains a system clock, keeping track of when the file is created, or image is captured.

15 ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the  
25 claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5

6. Claims 2-5, 8, 13, 19-22, 25, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (US 5,734,568) in view of Ulvr et al. (US 5,602,382, "Ulvr" hereinafter). The teachings of Borgendale have been discussed above.

Although Borgendale utilizes a mail piece identifier 24 in the form of a barcode,  
10 Borgendale fails to specifically teach or fairly suggest providing detailed description of the identification code, and its component parts.

Ulvr teaches a mail piece sorting/processing system utilizing a barcode identifying each mail piece. Ulvr further discloses component parts of the code such as start code, class code (or Postal code) and stop code (col. 1, line 66 – col. 2, line 8). The bar code further includes  
15 customer information (col. 1, lines 56 – 64) which can include customer address, a date (col. 9, lines 13+) as shown in figure 4b and machine ID (see abstract). Ulvr also uses parity bits (see figure 3 and 4a) and checksum method to ensure that the code is not in error condition. These status bits indicate an aspect of the identification mark as recited in claims 13 and 30.

In view of Ulvr's teaching, it would have been obvious to an ordinary skill in the art at  
20 the time the invention was made to employ well-known Postal code containing various information to the teachings of Borgendale in order to efficiently process each mail piece. For example, there may be an occasion to sort the mail by origin, class or time they were processed

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etc. etc. Furthermore, storage area (i.e., disk space, tapes, etc.) is relatively inexpensive, and the users can add more information to the code without incurring much cost. Thus, adding more fields for further processing as taught by Ulvr would have been an obvious extension to improve overall productivity of the system.

5

7. Claims 6 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (US 5,734,568) in view of Berson et al. (US 6039257, "Berson" hereinafter). The teachings of Borgendale have been discussed above.

Borgendale fails to specifically teach or fairly suggest that the barcode includes time data.

10 Berson teaches a mail piece sorting/processing system utilizing a barcode identifying each mail piece. The barcode contains identification data and also time-stamp data (col. 2, lines 30+).

In view of Berson's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate well-known time data to the teachings of Borgendale in order to accurately capture the time the mail piece was processed. Adding time data in addition to date would have been an obvious extension, well within the ordinary skill in the art. Furthermore, when modified address have to be applied to the transmitted file in order to correct the wrong addresses, it is critical to compare exact the time of transmittal and the time modified ed address file was created, and thus an obvious expedient.

20

8. Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (US 5,734,568) in view of in view of Ulvr et al. (US 5,602,382) and Berson et

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al. (US 6,039,257). The teachings of Borgendale as modified by Ulvr have been discussed in paragraph 1, and Borgendale as modified by Berson have been discussed in paragraph 2 above. Accordingly, Borgendale as modified by Ulvr and Berson would have all data elements listed in the claims.

5

9. Claims 15, 16, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (US 5,734,568) in view of Allum et al. (US 5,420,403, "Allum" hereinafter).

The teachings of Borgendale have been discussed above.

10 Borgendale fails to specifically teach or fairly suggest that the postal code in the file is a POSTNET code.

Allum teaches a mail piece sorting/processing system utilizing a POSTNET code identifying each mail piece (col. 3, lines 53+).

15 In view of Allum's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ notoriously old and well-known POSTNET code to the teachings of Borgendale in order to process each mail piece quickly and improve overall throughput of the system. Although conventional barcode or POSTNET code serves the purpose of identifying a mail piece, a POSTNET or modified POSTNET code improves speed of reading/printing such code, and thus an obvious expedient.

20

### ***Response to Arguments***

10. Applicant's amended claims and remarks filed on December 9, 2003 have been carefully considered, however, it is the Examiner's opinion that the cited reference to Borgendale still teach amended claims.

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In the first paragraph on page 10 of the remarks, Applicant argues, “For example, Borgendale et al. does not teach any method including retrieving identification information from an identification filed at a plurality of nodes on a mailpiece sorting system. Indeed, the Office Action did not even mention this claim element.” Applicant further states, “The sending  
5 location creates part of an electronic mailpiece folder .....”

As described in paragraph 2 above, electronic mailpiece folder is an identification file for the mail piece. As acknowledged by the Applicant, Borgendale’s embodiment comprises three nodes: a sending location, a remote processing system, and a destination location. As further shown in figure 3, the mail processing step further includes reading identification number from  
10 the mail piece (step 146) and retrieves information stored in the electronic folder (or identification file).

Perhaps, Borgendale’s particular embodiment may appear different from the claimed subject matter recited in this invention. Nevertheless, Borgendale teaches all elements recited in claim 1 and other claims.

15 In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5  
20 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Borgendale and the secondary references to Ulvr, Berson, and Allum are directed to a system and method for processing mail pieces. Utilizing



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POSTNET code for a barcode identification code, for example, is a modification one ordinary skill in the art could contemplate.

The amended claims and remarks describing these elements have been fully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final.

5

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahshik Kim whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday. The fax number directly to the Examiner is (571)273-2393.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

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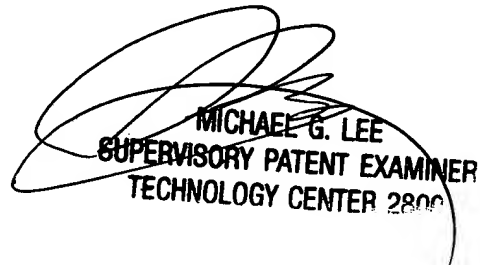
*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Patent Examiner  
Art Unit 2876

April 16, 2004



MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800